REMARKS

Filed concurrently with this paper is a Request for Continued Examination and fee pursuant to C.F.R. § 1.114.

Claims 19-35 and 37 are pending in the application, of which claims 19, 25 and 32 are in independent form. Claims 1-18 and 36 were previously canceled. Claims 19, 23, 25, 29, 32, 33, and 37 are amended herein.

In the Office Action mailed May 11, 2009 (the "Office Action"), claims 19-35 and 37 stand rejected under § 102 as purportedly being anticipated by U.S. Patent Publication No. 2004/0012631 to Skorski ("Skorski"). In the alternative, the Office Action purports that certain features of the claims are disclosed in U.S. Patent No. 7,496,543 to Bamford et al. ("Bamford").

In light of the amendments and remarks herein, the Applicants submit that the claims are in condition for allowance and respectfully request the same. Each issue raised in the Office Action is addressed in turn below.

EXAMINER INTERVIEW

The Applicants thank Examiner Thuy-Vi Nguyen and her Supervisor Dean Tan Nguyen for the in-person interview on June 23, 2009. In the interview, an agreement was reached regarding claim language. In particular, the Examiner agreed that the prior art cited in the Office Action does not disclose producing different views of the <u>same</u> object as read from the <u>same</u> database. In particular, the interview summary indicates agreement with respect to features clarifying that the recited views are of the "same tangible object" and are obtained from the "same data/database." *See* <u>Interview Summary</u> of June 23 Interview.

AMENDMENTS TO THE CLAIMS

Responsive to the Interview, the Applicants have amended the claims to clarify certain features. Claim 19 has been amended to recite:

> "A computer-implemented method of returning customized information from a computer-readable storage medium in response to requests about a specific tangible object having attributes, the method comprising:
> receiving at a computer a first request from a first venue for information on

the specific tangible object in inventory;

  reading a representation of the tangible object from the computer-readable storage medium, the representation including attributes of the specific tangible object;

  generating a first view of the specific tangible object, wherein the first view is generated by applying a first rule associated with the first venue to the representation of the specific tangible object such that the first view includes only attributes in compliance with the first rule;

  returning the first view to the first venue;

  receiving at the computer a second request from a second venue for information on the **same specific tangible object**;

  generating a second view of the **same specific tangible object**, wherein the second view is generated by applying a second rule associated with the second venue to the **same representation of the same specific tangible object read from the same computer-readable storage medium** such that the second view includes only attributes in compliance with the second rule, and wherein the second view differs from the first view in that at least one attribute included in the second view is not included in the first view; and

  returning the second view to the second venue." Emphasis added; *also see* claims 25 and 32.

REJECTION OF CLAIMS 19-35 AND 37 UNDER § 102

Claims 19-35 and 37 stand rejected under 35 U.S.C. § 102 as purportedly being anticipated by Skorski.

A claim is properly anticipated under 35 U.S.C. § 102 only if "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131, *citing* Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628 at 631 (Fed. Cir. 1987); emphasis added. "The identical invention must be shown in as complete detail as is contained in the . . . claim." MPEP §2131, citing Richardson v. Suzuki Motor Co., 868 F.2d 1226 at 1236 (Fed. Cir. 1989); emphasis added.

Skorski and Bamford fail to teach or suggest at least, "generating a second view of the same specific tangible object read from the same computer-readable storage medium… wherein the second view differs from the first view in that at least one attribute included in the second view is not included in the first view." Accordingly, the Applicants respectfully traverse the rejection of these claims.

The disclosure teaches generating "venue specific" views of an object. *See* Abstract. Each of the views may differ with respect to which <u>attributes</u> of a particular object stored in the database are displayed to the user. *See* Para. [0028].

For example, the disclosure teaches that a first venue may be allowed to access/display a <u>first set of attributes</u> of a particular specific tangible object while a second venue is allowed to access/display a <u>different set of attributes</u> of the <u>same specific tangible object</u>. *See* Para. [0019]. The attributes to be included in a particular venue are defined by a set of rules associated with the venues ("...may be restricted to certain information by Rules set up in accordance with the invention..."). <u>Id</u>. The disclosure teaches producing different views of a specific tangible object for display in different venues by applying rules associated with the venues to the **same specific tangible objects**:

> "..if a website is created as a venue to market pre-owned vehicles in the Seattle area to retail customers... The website accessible by this audience may constitute a venue to which many automobile dealers may wish to provide information about certain of their vehicles for retail sale. Similarly, a website for wholesale automotive customers nationwide may potentially constitute a venue, and the wholesale dealers may be an audience... the wholesale customers may be further subdivided by other traits or factors, such as for example unique needs by geographic region, thus implying separate geographic niche markets and <u>hence potentially separate audiences</u>... **the audience from a particular region may be restricted to certain information by Rules set up in accordance with the invention**...Thus, <u>distinct venues are created for each audience and each venue is defined by a set of unique 'rules' for customizing the information which may be displayed at the particular venue</u>, in this case a website(s)" [0019]; emphasis added.

As discussed above, the claims have been amended to clarify this feature. Specifically, claim 19 has been amended to recite:

> "...<u>generating a first view of the specific tangible object</u>, wherein the first view is generated by <u>applying a first rule associated with the first venue </u>to the representation of the tangible object such that <u>the first view includes only attributes in compliance with the first rule</u>..." Claim 19; emphasis added; *also see* claims 25 and 32.

Claim 19 further recites:

> "...generating a <u>second view of the **same specific tangible object**</u>, wherein the second view is generated by applying a second rule... to the <u>same representation of the same specific tangible object read form the same computer-readable storage</u>

medium...wherein ... at least one attribute included in the second view is <u>not included</u> in the first view..." Emphasis added; *also see* claims 25 and 32.

SKORSKI FAILS TO DISCLOSE RULES TO GENERATE DIFFERENT VIEWS OF THE SAME SPECIFIC TANGIBLE OBJECT AND/OR GENERATING THE VIEWS USING DATA READ FROM THE SAME COMPUTER-READABLE STORAGE MEDIUM

In contrast to the claims, Skorski discusses **modifying** an attribute (price) of an object using a template:

> "The template server includes <u>retailer specific information for **each retailer**</u> such as retailer description, custom page header and footer, contact information, tax information, shipping information, etc....

> "[to produce a retailer-specific template]... the retailer...select[s] various shipping **costing** and other variables. These steps define the filters operated by the template server to provide the retailer's web catalog its appropriate **content** and look." <u>Skorski</u> [0019], [0024]; emphasis added.

As is clearly illustrated above, Skorski does not produce a view using data in the "same" database. Rather, the <u>retailer-specific</u> templates are used to store custom information for each retailer. *See* <u>Skorski</u> [0019]. Therefore, Skorski cannot disclose generating different views of <u>the same specific tangible object</u> and/or generating the views using data read <u>from the same computer-readable storage medium</u>.

Moreover, Skorski fails to disclose <u>rules</u> by which one or more attributes may be included and/or excluded from a particular view. *See* claims 19, 25, and 32. Rather, Skorski discusses merging data read from a database with data in a retailer-specific template. *See* <u>Skorski</u> [0019]. For example, at [0028] Skorski states:

> "...The subset of product group identification for Orthopedists is further filtered differently according to specifications set by the specific retailers... Each retailer's information is then filtered through one of several alternative possible filters, for example, a format for an online catalog for purchases by patients; or a format for purchases by the retailer. Necessarily, in those alternative formats, <u>the pricing for a particular item will vary, as the patient accessing the online medical store for patients will view product information and see a displayed retail price, while the retailer physician's practice will see the same item at a different price</u>." <u>Skorski</u> [0028]; emphasis added;

Accordingly, the same attributes are viewed, but the values are modified (according

to the retailer-specific template). *See* Skorski [0019].   In contrast, and as discussed above, the claims recite rules for selecting different set of attributes in different views:

> "…wherein the second view differs from the first view in that at **least one attribute in the second view is not in the first view**…"   Claim 19; emphasis added; *also see* claims 25 and 32.

BAMFORD FAILS TO DISCLOSE RULES TO GENERATE DIFFERENT VIEWS OF THE SAME SPECIFIC TANGIBLE OBJECT AND/OR GENERATING THE VIEWS USING DATA READ FROM THE SAME COMPUTER-READABLE STORAGE MEDIUM

Like Skorski, Bamford primarily discusses changing the pricing of products in an e-commerce context. ("A pricing engine for electronic commerce allows the owner of an electronic market place to dynamically change the pricing available at the electronic marketplace based on several factors…") Bamford Abstract.   Bamford discusses a "local or remote title/pricing module… used to determine the pricing schedule received by a customer…" Bamford col. 2 lines 60-64.   As discussed above, however, changing a price according to retailer- or customer- specific data is not what is claimed.   The claims do not recite changing the value of a particular piece of data (*e.g.,* pricing),; rather, the claims recite rules to determine which attributes are to be included in a view of the same object and stored in the same database. *See* claims 19, 25, and 32.   A module to generate a particular value (*e.g.,* generate a price) cannot disclose this feature.

NEITHER SKORSKI NOR BAMFORD ANTICIPATE THE CLAIMS

Since neither Skorski nor Bamford disclose at least, "generating different views of the same specific tangible object" and/or generating the views using data read from the "same computer-readable storage medium," the Applicants respectfully traverse the rejection of claims 19-35 and 37.

REMARKS REGARDING NON-FUNCTIONAL DESCRIPTIVE MATERIAL

The Office Action includes the following statement with respect to claim 19:

"Note: This appears to be a 'data processing' method, therefore, the limitation after 'data' or 'information or 'attribute' or 'view' or 'specific tangible object' etc., have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. *See* MPEP § 2106.01"

The Applicants point out that claim 19 recites more than a mere "data structure." Rather, claim 19, as in In re Lowry, recites "physical entities that provide increased efficiency in computer operation," which are "not analogous to printed matter." In re Lowry 32 F.3d 1584; emphasis added.

According to MPEP § 2106.01:

"...'functional descriptive material' consists of **data structures and computer programs** which **impart functionality** when employed as a computer component. (The definition of 'data structure' is 'a physical or logical relationship among data elements, designed to support specific data manipulation functions.' The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) 'Nonfunctional descriptive material' includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

"Both types of 'descriptive material' are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is **recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized**. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and >In re< *Warmerdam*, 33 F.3d *>1354,< 1360-61, 31 USPQ2d *>1754,< 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory)." MPEP § 2106.01; emphasis added.

Claim 19 recites "specific tangible objects" having attributes that are stored on a "computer-readable storage medium." *See* claim 19. Claims 25 and 32 recite similar structures. The claims recite a structural and function interrelation between the computer-

readable storage medium and technology which would permit the function of the material to be realized. *See* MPEP § 2106.01; *see also* <u>In Re Lowry</u>.

For example, claim 19 recites a <u>computer-readable storage comprising instructions to perform a method</u> including instructions to generate a first view of a specific tangible object and a second tangible object, "wherein the second view differs from the first view in that at least one attribute in the second view is not in the first view." Moreover, the Board of Patent Appeals and Interferences (BPAI) has determined that claims in the form of claim 18 <u>are patentable under § 101</u> (and, as such, should be given patentable weight). *See* <u>Ex parte Bo Li</u> Appeal 2008-1213 (BPAI November 6, 2008); *also see* In re <u>Bilski</u> 545 F.3d 943 (Fed. Cir. Oct. 30, 2008). Therefore, the Applicants respectfully submit that <u>all of the</u> features recited in claim 19 should be given their due patentable weight.

GENERAL CONSIDERATIONS

By the remarks provided herein, the Applicants have addressed all outstanding issues presented in the Office Action. The Applicants note that the remarks presented herein have been made merely to clarify the claimed invention from elements purported by the Office Action to be taught by the cited references. Such remarks should not be construed as acquiescence, on the Applicants' part, as to the purported teachings or prior art status of the cited references, nor as to the characterization of the cited references advanced in the Office Action. Accordingly, the Applicants reserve the right to challenge the purported teachings and prior art status of the cited references at an appropriate time.

CONCLUSION

For the reasons discussed above, the Applicants submit that the claims are in proper condition for allowance, and a Notice of Allowance is respectfully requested. If the Examiner notes any further matters that may be resolved by a telephone interview, the Examiner is encouraged to contact John Thompson by telephone at (801) 578-6994.

Respectfully submitted,

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